

Application No.: 09/810,883
Attorney Docket No.: TNX 98-08-01
Response to June 3, 2004 Office Action
Customer No.: 26839

REMARKS/ARGUMENTS

Claims 29-31, 33-43, and 45-46 are now pending in this application. Applicants have amended claims 29, 37, 40 and 42 to more distinctly and particularly claim that which Applicants regard as their invention; claims 32 and 44 have been cancelled. No new matter has been introduced by this amendment.

I. Objection Under 35 U.S.C. § 132

Claims 29-44 have been objected to as containing new matter. It is alleged that there is no support for the proviso "wherein the ITIM is not KIR". Applicants respectfully traverse this rejection.

The application discloses and claims determinants that target and bind to ITIMs. It is well known that KIR contains an ITIM and thus is inherently disclosed by the application. In rejecting a claim under the first paragraph of 35 U.S.C. § 132 as containing new matter, the Office must establish that the originally-filed disclosure would not have reasonably conveyed to one having ordinary skill in the art that the applicant had possession of the now claimed subject matter. Adequate descriptive support, particularly with respect to provisos, does not require literal support for the proviso. *In re Wertheim*, 191 U.S.P.Q. 90, 98 (CCPA 1976). The originally filed disclosure provides support as long as it would have reasonably conveyed to one having ordinary skill in the art that an applicant had possession of the concept of what is now claimed. *In re Anderson*, 176 U.S.P.Q. 331, 336 (CCPA 1973).

In the present claims, Applicants seek nothing more than to limit the claimed invention by excluding a certain species of a clearly described genus. The compounds defined in the proviso fall within the original genus of compounds defined in the

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specification. Consequently, Applicants fall directly within the rationale of *Wertheim*. *Wertheim* held that to rule that the entire genus isn't patentable because the applicant erroneously thought he was the first to invent the genus of compounds when he filed his application would exalt form over substance. 191 U.S.P.Q. 90, 97 (C.C.P.A. 1976). The present situation, like that in *Wertheim*, does not involve a new matter, rather, something within the originally claimed genus is being excised to overcome the prior art. *Wertheim* approved that approach, and the Office has no reason to treat applicants any differently. Moreover, as stated in *re Johnson*, 194 USPQ 187, 196 (CCPA 1977), "the specification having described the whole, necessarily described the part remaining".

Thus, Applicants submit that the added negative limitation in the claim does not introduce new matter and the objection should be withdrawn. Moreover, this objection should not apply to the new amendment made to claims 29, 37, 40 and 42 for the same reasons presented above.

II. Rejections Under 35 U.S.C. § 102(b)

Claims 29, 31, and 33-43 have been rejected as anticipated by Daeron et al. (EP 0861 891). The Office asserts that Daeron et al. teach bispecific antibodies capable of crosslinking a stimulatory ITAM and a KIR or KIR homologue, such as gp49B1, which contains an ITIM. The Office asserts that the amendment adding the negative limitation "wherein the ITIM is not KIR" does not exclude KIR homologues such as gp46B1 because they are distinct molecules. Applicants respectfully disagree.

Applicants intended the amendment to include a subgenus of ITIMs by referencing KIR thus excluding all homologues. However, in order to expedite prosecution,

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Applicants have amended the claims to exclude KIR and all of its homologues. In view of the amendment, Applicants respectfully request that the rejection be withdrawn.

III. Rejections Under 35 U.S.C. § 103(a)

A. Claims 32 and 44 have been rejected as unpatentable over Daeron et al. (EP 0 861 891) in view of Arm et al. (J Immunol. Vol 159, 2342-2349 (1997)). This rejection is moot in view of the cancellation of claims 32 and 44.

Applicants respectfully request that the rejection be withdrawn.

B. Claim 30 has been rejected as unpatentable over Daeron et al. (EP 0 861 891) in view of Queen et al. 5,530,101. Applicants submit that in view of the amendment to claim 29, Daeron et al. does not teach the claimed invention as discussed in section II above. Queen merely teaches the humanization of antibodies and does not provide any disclosure with regard to ITIM or ITAM. Therefore, this rejection should be withdrawn.


Conclusion

In view of the foregoing amendments and remarks, Applicants assert that the application is in condition for allowance and request a notice of same.

Respectfully Submitted,

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